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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,809	02/05/2001	Se June Hong	YOR9-2000-0776US1	2265

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WHITHAM, CURTIS & CHRISTOFFERSON, P.C.
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RESTON, VA 20190

EXAMINER

JANVIER, JEAN D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 04/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/773,809

Applicant(s)

HONG ET AL.

Examiner

Jean D Janvier

Art Unit

3622

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-8 is/are objected to.
- 8) ☒ Claim(s) 1-3 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response To Applicant's Amendment

Applicant's newly added claims 9-14 will not be entered because independent claim 9 is merely a duplicate of amended claim 3, which was not entered in the last response. Indeed, Independent claim 9 combines limitations from restricted claim 1 with claim 3 as originally submitted. This new arrangement does not help advance prosecution since the rationale for making the restriction in the same first place is still the same. Applicant is once again required to elect a group of claims (1-2 or 3-8) for prosecution on the merits. Therefore, the Applicant's response to the restriction requirement, under 121, is non-responsive. See below.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-2 are drawn to a method and system for making prioritized recommendation of items to a user based on preferences.
- II. Claims 3-8 are drawn to a method and system for collecting statistical data and pre-computing model parameters from the statistical data.

Inventions I and II are related as combination and subcombination. Inventions I and II in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). Indeed, the subcombination related to a process for computing statistical data from the training data, which

Art Unit: 3622

does not have to take into account the preferences based on associative and renewal buying history of claim 1 of the combination.

Claim Because the Inventions are distinct for the reasons cited above, the restriction is said to be proper.

Finally, it appears that the Applicant can overcome the restriction requirement by canceling claims 1-8, thereby leaving claims 9-14 pending. To this end, the Applicant is encouraged to call the Examiner to briefly discuss this new claim arrangement.

Conclusion

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113. Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final- 703-872-9327

Non-Official Draft- 703-746-7240

Before Final -703-872-9326

Customer Service- 703-872-9325

Application/Control Number: 09/773,809

Page 4

Art Unit: 3622

A handwritten signature in black ink, appearing to read "Jean D. Janvier". The signature is fluid and cursive, with the first name "Jean" being more prominent.

JDJ

Jean D. Janvier

01/28/04

Patent Examiner

Art Unit 3622